



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/957,187 | 10/24/97 | BEER | E 514425-3566 |

WILLIAM F LAWRENCE
CURTIS MORRIS & SAFFORD
530 FIFTH AVENUE
NEW YORK NY 10036

IM71/1104

EXAMINER

AHMED, S

ART UNIT

PAPER NUMBER

1773

DATE MAILED 11/04/98

**Please find below and/or attached an Office communication concerning this application or
proceeding.**

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/957,187

Applicant(s)
Beer et al.

Examiner
Sheeba Ahmed

Group Art Unit
1773



☒ Responsive to communication(s) filed on Oct 24, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1773

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention.

Claim 1 recites a mono- or multilayer film comprising at least one layer of a cycloolefin polymer or of a mixture of cycloolefin polymers with one or more thermoplastics. There is not clear written description, in the claims or the specification, of how to make "a mixture of cycloolefin polymers with one or more thermoplastics". Does the "mixture of cycloolefin polymers with one or more thermoplastics" refer to a polymer blend or a copolymer?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1773

2. Claims 2, 3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation that the cycloolefin polymer is selected from a class of polymers "comprising" polymerized units of at least one cyclic olefin of the formulae I, II, III, IV, V or VI. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. The use of the term "comprising" in claim 2 is improper since it leaves the claim open-ended. A proper alternative expression would recite selection from a class of polymers "consisting" of polymerized units of at least one cyclic olefin of the formulae I, II, III, IV, V, or VI. See MPEP § 2173.05(h) and *Ex Parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

Claim 2 further recites the limitation that the substituents may be hydrocarbon radicals "such as" linear or branched alkyl radicals and so on. The phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 3 recites the limitation that the cycloolefin polymer is obtained by ring-opening polymerization of at least one of the monomers having the formula I to VI. There is insufficient antecedent basis for this limitation in the claim. Monomers having the formula I to VI are first recited in claim 2. The wording of claim 3 is indefinite.

Art Unit: 1773

Claim 8 recites that the blister pack may be used "for storing and transporting pharmaceutical products, particularly dry oral preparations". The use of the word "particularly" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 2, 3 and 8 should be amended to clarify what is meant to be encompassed by these claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 7, and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamamoto et al. (U.S. 5,783,273).

Yamamoto et al. disclose a blister package which has superior moistureproof properties. The blister package material comprises a mono- or multilayer film of polyolefin resins (Refer to the Abstract). The film contains at least one layer of a non-crystalline polyolefin resin or a film composed of at least one layer of a non-crystalline polyolefin resin and at least one layer of a crystalline polyolefin resin (Column 3, lines 43-49). Examples of non-crystalline polyolefin resins

Art Unit: 1773

that may be used include a cycloolefin random copolymer, the ring-opening product of the cycloolefin random copolymer and the hydrogenation product of the cycloolefin random copolymer (Column 3, lines 56-62). The cycloolefin random copolymer comprises a cycloolefin component and either ethylene or other unsaturated monomers. The cycloolefin component of the cycloolefin random copolymers is based on the structure (1) given in Column 3. The substituents on the general cycloolefin structure may be a hydrogen atom, halogen atoms or hydrocarbon groups (Column 4, lines 8-10). Hydrocarbon substituents include general alkyl groups having 1-20 carbon atoms, cycloalkyl groups having 3-15 atoms, aromatic hydrocarbons or mono- or polycyclic rings formed by combining some of the substituents (column 4, lines 13-27). Examples of unsaturated monomers that may be used in place of ethylene are alpha-olefins having 3-20 carbons (examples include propylene, 1-butene, 4-methyl-1-pentene), hydrocarbon-based monomers having at least two carbon-carbon double bonds (examples include 2-norbornene, 5-vinyl-2-norbornene, and norbornadiene), and cycloolefins (examples include cyclobutene, cyclopentene, dimethylcyclohexene) (Column 29, lines 8-53). The unsaturated monomer units are usually employed in an amount not exceeding 50 mole % based on the total moles of the comonomers in the copolymer (Column 29, lines 54-58). In addition, the polyolefin resins may contain subsidiary components, for example, impact strength improving rubbers, heat stabilizers, photo stabilizer, anticlouding agents, pigments, and light permeable fillers (Column 40, lines 45-51). All elements of the claimed invention are either recited or inherent in the above reference.

Art Unit: 1773

4. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Brekner et al (U.S. 5,422,397).

Brekner et al. disclose polymer alloys based on at least one thermoplastic, such as an aromatic polyether-amide, and at least one cycloolefin polymer (Refer to the Abstract). The cycloolefin polymers are derived from structural units given in Column 7. The substituents on these general structures include hydrogen atoms and alkyl groups having 1-8 carbons (Column 8, lines 1-5). Particularly preferred cycloolefins are norbornene and tetracyclododecane (Column 8, lines 24-26). Of the monocyclic olefins used, cyclopentene is particularly preferred (Column 8, lines 27-29). The polymer alloys may also contain constituents resulting from the ring-opening of these cycloolefin polymers (Column 8, lines 64-66). The limitations of water vapor permeation and puncture resistance are considered to be inherent due to the fact that the polymeric product appears to be the same as that claimed by the applicants. All elements of the claimed invention are either recited or inherent in the above reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1773

5. Claims 1-4, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al.

Yamamoto et al. disclose the claimed invention except for a few specific cycloolefin monomers that may be used in the synthesis of the cycloolefin polymers. However, these additional cycloolefin monomers are homologues of the cycloolefin monomers disclosed by Yamamoto et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the cycloolefin monomers of Yamamoto et al. with homologues given the reasonable expectation of equivalent results and absent a showing otherwise.

6. Claim 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. in view of Tanaka et al. (U.S. 5,556,920).

The claimed invention differs from Yamamoto et al. in the addition of fillers to the films and the monoaxial stretching during fabrication. However, Tanaka et al. disclose a monoaxially stretched polypropylene film composition comprising a crystalline polypropylene and a monocyclic olefin polymer (Refer to the Abstract). The monoaxially stretched film may be subjected to traverse stretching of 4- to 15-fold (Column 8, lines 30-32). Anti-blocking agents may be added to the stretched films (Column 6, lines). Examples of inorganic anti-blocking agents that may be used include silica, alumina, and calcium carbonate (Column 6, lines 66-67). Accordingly, it would have been obvious to one of ordinary skill in the art to fabricate polymeric films that contain fillers and are monoaxially stretched particularly since Tanaka et al. suggest

Art Unit: 1773

such stretching and addition of anti-blocking agents leads to films of improved transparency, image clarity and formability (Column 8, lines 40-43 and 51-56).

Conclusion


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594. The examiner can normally be reached on Monday-Friday from 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached at (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.

Sheeba Ahmed

October 29, 1998


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700